

ESTTA Tracking number: **ESTTA416800**

Filing date: **06/28/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

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| Name | Celerant Consulting Holdings Limited Company |
| Granted to Date of previous extension | 06/29/2011 |
| Address | Avalon House 72 Lower Mortlake Road Richmond, Surrey, TW9 2JY UNITED KINGDOM |
| Attorney information | BRAD R NEWBERG REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042 UNITED STATES bnewberg@reedsmith.com Phone:703-641-4272 |

Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 85078208 | Publication date | 03/01/2011 |
| Opposition Filing Date | 06/28/2011 | Opposition Period Ends | 06/29/2011 |
| Applicant | Excelerant, LLC P.O. Box 82034 Lafayette, LA 70503 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 035. First Use: 2010/03/19 First Use In Commerce: 2010/06/16
All goods and services in the class are opposed, namely: Business consulting services; providing organizational development consulting services with regard to company goals and structure, work team goals and structure, and leadership development


Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Marks Cited by Opposer as Basis for Opposition

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| U.S. Registration No. | 2813450 | Application Date | 02/12/2001 |
| Registration Date | 02/10/2004 | Foreign Priority Date | NONE |
| Word Mark | CELERANT CONSULTING | | |

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| Design Mark | CELERANT CONSULTING | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 035. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 BUSINESS MANAGEMENT AND ORGANIZATION CONSULTANCY; BUSINESS RESEARCH; BUSINESS OPERATIONS MANAGEMENT; OPERATIONS MANAGEMENT CONSULTANCY; BUSINESS MANAGEMENT CONSULTANCY SERVICES; BUSINESS OPERATIONS ANALYSIS AND CONSULTATION; PROJECT MANAGEMENT OF IMPLEMENTATION OF OPERATIONS STRATEGY OF BUSINESSES; STATISTICAL INFORMATION SERVICES; ACCOUNTANCY SERVICES; COST PRICE ANALYSIS; BUSINESS AUDITING; BUSINESS APPRAISALS; DATA PROCESSING; MARKET RESEARCH; ASSET MANAGEMENT CONSULTING SERVICES, NAMELY, THE OPTIMIZATION OF PHYSICAL ASSETS TO DELIVER SUSTAINABLE FINANCIAL IMPROVEMENT IN OPERATIONAL EFFICIENCY AND EFFECTIVENESS; BUSINESS MANAGEMENT CONSULTATION PROVIDED TO MULTIPLE SECTORS</p> <p>Class 036. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 FINANCIAL MANAGEMENT, PLANNING AND ASSET MANAGEMENT SERVICES</p> <p>Class 042. First use: First Use: 2001/05/02 First Use In Commerce: 2001/05/02 INFORMATION TECHNOLOGY CONSULTANCY SERVICES; COMPUTER CONSULTATION, NAMELY, PROVISION OF INFORMATION RELATING TO THE IMPLEMENTATION OF COMPUTERIZED BUSINESS SYSTEMS AND COMMUNICATIONS SYSTEMS; TELECOMMUNICATIONS CONSULTATION, NAMELY, PROVISION OF INFORMATION RELATING TO THE IMPLEMENTATION OF COMPUTERIZED BUSINESS SYSTEMS AND COMMUNICATIONS SYSTEMS; DEVELOPMENT OF NEW TECHNOLOGY FOR OTHERS IN THE FIELD OF DEVELOPMENT OF NEW INFORMATION BUSINESS SYSTEMS, DECISION MAKING AND REPORTING SYSTEMS AND TECHNOLOGY PRODUCT DEVELOPMENT CONSULTATION RELATING THERETO; [COMPUTER PROGRAMMING SERVICES FOR OTHERS; COMPUTER SERVICES, NAMELY, DESIGNING AND IMPLEMENTING WEBSITES FOR OTHERS; HOSTING THE WEBSITE OF OTHERS ON A COMPUTER SERVER FOR A GLOBAL COMPUTER NETWORK; COMPUTER SERVICES, NAMELY, PROVIDING INFORMATION, ADVICE AND CONSULTATION IN THE AREA OF COMPUTER PROGRAMMING, DEVELOPMENT AND HOSTING OF WEBSITES; TECHNICAL CONSULTATION IN THE FIELD OF COMPUTER PROGRAMMING, DEVELOPMENT AND HOSTING OF WEBSITES;] COMPUTER CONSULTATION, NAMELY, PROVIDING CONSULTATION RELATING TO THE IMPLEMENTATION OF COMPUTER BUSINESS SYSTEMS, DEVELOPMENT OF NEW INFORMATION BUSINESS SYSTEMS, DECISION MAKING AND REPORTING SYSTEMS, AND TECHNOLOGY PRODUCT DEVELOPMENT CONSULTATION RELATING THERETO</p> | | |
| U.S. Registration No. | 3137969 | Application Date | 11/23/2004 |
| Registration Date | 09/05/2006 | Foreign Priority Date | NONE |
| Word Mark | CELERANT | | |

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| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | <p>Class 035. First use: Accountancy services; advertising agencies, dissemination of advertising for others via the Internet, direct mail advertising and business marketing consulting services; market analysis in the field of advertising; market research; business auditing; account auditing; business appraisals; business information services relating to market research, business research, cost/price analysis, economic forecasting and analysis and market survey; business information services provided online from a computer database or the Internet relating to services relating to market research, business research; cost/price analysis, economic forecasting and analysis and market survey; business management; business research; preparing advertisements for others; consultancy relating to operational strategy of businesses; cost/price analysis; database management services; data processing; economic forecasting and analysis; business management consultancy services and risk management; business management consultancy services provided to multiple sectors; market research; conducting market research surveys; consultation in the fields of business management; business organization consultancy; personnel management consultation; preparing business reports for others; providing statistical information</p> <p>Class 036. First use: Insurance brokerage; financial planning; financial analysis and consultation for businesses; financial management; financial analysis and consultation in the fields of financial restructuring value-based management, executive compensation design, privatization, mergers, acquisitions, alliances and joint ventures, takeover defense, financial engineering, asset options, hedging and risk management; consultation in the field of asset management, for the optimization of physical assets to deliver sustainable financial improvement in operational efficiency and effectiveness; providing information in the fields of the above</p> <p>Class 042. First use: Computer hardware and software consulting services; computer programming for others; computer services, namely, data recovery services; computer network design for others; graphic design for the compilation of web pages on the Internet; providing technical support in the nature of troubleshooting computer hardware and software problems; design, creation, hosting, maintenance of web sites for others; information technology consultancy services; consulting services related to the design, selection, implementation and use of computer hardware and software for business system use; providing information and consultation in the field of computer systems containing business information; providing information in the field of implementation of business computer systems for the purpose of aiding in a consumer's purchasing decision</p> |

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| Attachments | 76209982#TMSN.gif (1 page)(bytes) 78521872#TMSN.jpeg (1 page)(bytes) Excelerant Opposition.pdf (5 pages)(148253 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

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| Signature | /brad r. newberg/ |
| Name | BRAD R NEWBERG |
| Date | 06/28/2011 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CELERANT CONSULTING HOLDINGS
LIMITED COMPANY,

Opposer,

v.

EXCELERANT LLC,

Applicant.

Opposition No. _____

App. No.: 85,078,208
Filing Date: July 6, 2010
Pub. Date: March 1, 2011
Mark: EXCELERANT & design

NOTICE OF OPPOSITION

Opposer, Celerant Consulting Holdings Limited Company (“Celerant”), a consulting services business duly organized and existing in the United Kingdom, and having operations within the United States, will be damaged by the registration of the mark shown in trademark application number 85,078,208 (hereinafter “the ‘208 Application”), filed by Applicant Excelerant, LLC. Celerant hereby opposes the application pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.101.

As grounds for opposition, Celerant alleges:

1. Since at least as early as May 2, 2001, Celerant has used its “Celerant Marks” which prominently feature the word mark CELERANT. *See* U.S. Trademark Registration Nos. 2,813,450 (“CELERANT CONSULTING” in International Classes 35, 36, and 42) and 3,137,969 (“CELERANT” in International Classes 35, 36, and 42) (collectively the “Celerant Marks”).

2. Celerant has used its Celerant Marks on and in connection with, *inter alia*, many types of consulting services in the United States, and such use has been continuous to this day. Celerant has continuously used the Celerant Marks in commerce on and in connection with such goods and services in the United States since at least as early as May 2, 2001, and such use continues to this day.

3. Celerant and the Celerant Marks have become famous as a result of extensive commercial use and of highly favorable publicity. Founded in 1987, Celerant is a multi-national company and one of the largest consulting companies in the world—and is the largest independent global firm working in the operations management sector of consulting. Therefore, in addition to and including its United States trademark registrations, Celerant has acquired substantial statutory and common law rights related to its Celerant Marks. Celerant thus has sufficient standing to initiate the instant Opposition based on Applicant's use and attempted registration of a confusingly similar mark on identical and closely related goods and services which would directly damage Celerant and dilute its Celerant Marks.

4. The "EXCELERANT" mark featured in the '208 Application is similar in sound and appearance to the Celerant Marks. In fact, it is an exact duplicate of the fanciful and trademarked term "CELERANT" with the only addition being an "EX" at the beginning.

5. The '208 EXCLERANT Application identifies nearly identical goods and services as Celerant's 2,813,450 and 3,137,969 trademark registrations. For example, the EXCLERANT Application claims, in full, the services of "Business consulting services; providing organizational development consulting services with regard to company goals and structure, work team goals and structure, and leadership development." CELERANT Registration 2,813,450 claims, among other related services, "Business management and organization consultancy," "Operations management consultancy," "Business management consultancy services," "Business operations analysis and consultation," "Asset management

consulting services,” and “Business management consultation provided to multiple sectors.” CELERANT Registration 3,137,969 claims, among other related services, “business management,” “consultancy relating to operational strategy of businesses,” “business management consultancy services and risk management,” “business management consultancy provided to multiple sectors,” “consultation in the fields of business management,” “business organization consultancy,” “personnel management consultation,” “financial analysis and consultation for businesses,” “executive compensation design,” and “consultation in the field of asset management, for the optimization of physical assets to deliver sustainable financial improvement in operational efficiency and effectiveness.”

6. Given the substantial similarities between the mark featured in the ‘208 Application and the Celerant Marks, as set forth in the preceding paragraphs, as well as the similar services, channels of trades, and potential customers, the mark featured in the ‘208 Application is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Celerant, or as to the origin, sponsorship, or approval of Applicant’s services or activities by Celerant (which they are not).

7. Moreover, Applicant’s use of the mark in the ‘208 Application dilutes the distinctive character of the Celerant Marks and its established goodwill.

8. Based on Celerant’s averments herein, the ‘208 Application should be denied.

WHEREFORE, Celerant hereby moves the Board for an Order denying registration of United States Trademark Application No. 85,078,208.

Respectfully submitted,

Dated: June 28, 2011

/Brad R. Newberg/
Brad R. Newberg
bnewberg@reedsmith.com

REED SMITH LLP
3110 Fairview Park Drive., Ste. 1400
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(703) 641-4272

Attorneys for Opposer,
Celerant Consulting Holdings Limited Company

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant by mailing said copy on June 28, 2011, via First-Class U.S. mail postage-prepaid to the attorney of record for Application No. 85,078,208:

Jesse D. Lambert, Esq.
Law Office of Jesse D. Lambert, L.L.C.
1018 Harding Street, Suite 102 B
Lafayette, LA 70503

It is also being served on Mr. Lambert electronically as of the same date.

Dated: June 28, 2011

/Brad R. Newberg/
Brad R. Newberg